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Application No. 10/654,661
December 11, 2006

REMARKS/ARGUMENTS

Applicants kindly thank Examiner Acquah for his helpful comments in the outstanding Office Action.

Claims 65, 76, 77, and 100 are amended to state that the fatty acid is tall oil fatty acid, Monomer, or mixtures thereof. Support for the amendments is found at pages 41-48 of the originally filed specification and original Claims 76 and 77.

Claims 65-86, 95-103, and 106-110 remain pending. Favorable reconsideration is respectfully requested in light of the Remarks below.

The rejections of Claims 65-86, 95-103, and 106-110 under 35 USC §102(b) over WO 98/58002 (WO'002) is believed to be obviated by the amendment above combined with the remarks provided below.

The present invention relates, in part, to a process for preparing a resin by reacting, at an elevated temperature, rosin, fatty acid, aldehyde, and phenolic compound that is at least trifunctional where the phenolic compound that is at least trifunctional constitutes at least 25 wt% of the phenolic compounds, and *where the fatty acid is tall oil fatty acid (TOFA), Monomer, or mixtures thereof* (See amended Claims 65 and 100), as well as resins made by this process and varnishes and inks containing such resins (See Claims 96-99 and 107-100). Monomer is described in great detail within the present application at page 47, line 14, to page 48, line 21. In short, Monomer is derived directly from tall oil fatty acid (TOFA) as well as other compositions containing predominantly unsaturated fatty acids, not from distilled tall oil (DTO). Monomer is the result of a polymerization process of tall oil fatty acid (TOFA) as well as other compositions containing predominantly unsaturated fatty acids that yields dimer fatty acid and a residual mixture of monomeric fatty acids. The residual mixture of monomeric fatty acids is known as, and is generally accepted in the art as Monomer. The uniqueness of Monomer as chemically distinct has been identified and accepted by leading authorities. For example, Monomer has been assigned its own Chemical Abstracts Service Number (CAS #), which is 68955-98-6. This clearly demonstrates that the

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leading authorities in the related technical field have accepted the differences between Monomer and tall oil fatty acid; and, further accepted that such differences make them chemically distinct.

WO'002 discloses, at best, a process of making a resin by reacting rosin, Distilled Tall Oil, aldehyde and a phenol containing organic compound (see pages 2-8). It should be stressed that WO'002 discloses that Distilled Tall Oil (DTO) be used, rather than Tall Oil Fatty Acid (TOFA), Monomer and/or Crude Tall Oil (CTO) by disclosing:

"The present invention provides for the preparation of useful resins from distilled tall oil (DTO)." (see page 3, lines 15-16).

Further, WO'002 discloses that

"DTO is not . . . tall oil fatty acid" (see page 4, lines 23-24).

Moreover, WO'002 discloses at great length how distilled tall oil is a composition that is chemically distinct from any other tall oil products at page 3, line 15 to page 7, line 10, specifically contrasting distilled tall oil from tall oil fatty acid at page 6, lines 11 to 23. Still further, WO'002 describes distilled tall oil as one particular fractionation product of crude tall oil and not one result of a polymerization reaction (like that of Monomer mentioned above). To substantiate the statements in WO'002, the Office should be aware that distilled tall oil has been assigned a completely different Chemical Abstracts Service Number (CAS #), which is 8002-26-4. Still further, tall oil fatty acid has been assigned its own Chemical Abstracts Service Number (CAS #), which is 61790-12-3. Finally, as mentioned above, Monomer also has been assigned its own Chemical Abstracts Service Number (CAS #), which is 68955-98-6.

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The above clearly demonstrates that the leading authorities in the related technical field have accepted the differences between tall oil fatty acid and distilled tall oil; and, further accepted that such differences make them chemically distinct. Accordingly, WO'002 fails to disclose or suggest a process for preparing a resin by reacting, at an elevated temperature, rosin, fatty acid, aldehyde, and phenolic compound that is at least trifunctional where the phenolic compound that is at least trifunctional constitutes at least 25 wt% of the phenolic compounds, *where the fatty acid is tall oil fatty acid (TOFA), Monomer, or mixtures thereof*, as well as resins made by this process and varnishes and inks containing such resins. In fact, because WO'002 discloses the importance for the presence of distilled tall oil to be in its reaction, the skilled artisan would not only understand that only distilled tall oil is to be utilized, but also would not be motivated to utilize Monomer and/or tall oil fatty acid (TOFA) therein the reaction mixture disclosed by WO'002. Therefore, WO'002 teaches away from the use of Monomer and/or tall oil fatty acid (TOFA) therein the reaction mixture disclosed therein.

Again, the present invention relates to a process for preparing a resin by reacting, at an elevated temperature, rosin, fatty acid, aldehyde, and phenolic compound that is at least trifunctional where the phenolic compound that is at least trifunctional constitutes at least 25 wt% of the phenolic compounds, *where the fatty acid is tall oil fatty acid (TOFA), Monomer, or mixtures thereof* (See amended Claims 65-and 100), as well as resins made by this process and varnishes and inks containing such resins (See Claims 96-99 and 107-100). In light of all of the above, WO'002 not only fails to disclose or suggest the claimed invention, it actually teaches away from the claimed invention. Accordingly, Applicants respectfully request this ground of rejection to be withdrawn.

Claims 65-86, 95-103, and 106-110 are rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-29 of copending United States Patent Application 10/384,075.

Responsive thereto, Applicants provide herewith attached a signed Terminal Disclaimer over United States Patent Application 10/384,075 and Statement under 37 CFR

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3.73(b). The filing of the Terminal Disclaimer is not to be considered as an admission and/or comment whatsoever on the merits of the above-mentioned rejection. Instead, for the sake of efficient prosecution of the claimed invention, the Terminal Disclaimer is filed. Applicants reserve the right, at a later date, to claim additional subject matter that may or may not be interpreted to fall within the scope of subject matter closely related to United States Patent Application 10/384,075 in any Divisional/Continuation/Continuation-In-Part Application.

In light of the above, Applicants respectfully request withdrawal of this ground of rejection.

Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact below-signed by telephone.

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Please charge the amount of \$1020.00 required for the request for extension of time to our Deposit Account No. 09-0525. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 09-0525. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

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